

**REMARKS**

Claims 24, 26-44, 47-52, 55-56, and 80-103 are pending in the present application.

Applicants have amended claims 24, 26, 44, 82, 83, 91 and 98-100. Support for the amendment to claims 24 and 26 can be found in the specification on page 1, 1<sup>st</sup> full paragraph, the paragraph bridging pages 2 and 3, and the 1<sup>st</sup>, 2<sup>nd</sup> and 3<sup>rd</sup> full paragraphs of page 3. The amendments to claims 83 and 91 are supported by claims 24 and 26, respectively, and the specification on page 8, 2<sup>nd</sup> full paragraph through and including page 9, 1<sup>st</sup> full paragraph. No new matter has been added.

**I. Rejection under 35 U.S.C. § 112, Second Paragraph**

Claims 44, 82 and 98-100 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicants have obviated this rejection by deleting the phrase “wax-like substance having a melting point of at least 50°C”. Accordingly, Applicants request that this ground for rejection be withdrawn.

**II. Rejection under 35 U.S.C. § 102(b)**

Claims 24, 26-37, 42-44, 47-50, 56, 80 and 81 stand rejected under 35 U.S.C. § 102(b) as anticipated by Lauterbach (U.S. Patent No. 4,614,674) or Chang et al. (U.S. Patent No. 5,472,649). Applicants respectfully traverse the rejection.

According to MPEP § 2131, to establish a *prima facie* case of anticipation, the reference must teach each and every element of the claim. Applicants respectfully submit that neither Lauterbach nor Chang et al. teaches each and every element as recited in Applicants’ independent claims 24 and 26.

Lauterbach teaches “epoxy resin/polyester powder coating compositions which contain wax or wax-like substances in conjunction with metal compounds as matting agents.” (Lauterbach at column 1, lines 5-8). Thus, Lauterbach’s powder coating

composition is made up of the typical polyester binder and epoxy cross-linking agent, together with a matting agent that is made up of a wax and a metal compound. (Lauterbach at column 1, lines 33-38 and column 4, lines 32-42). In direct contrast, the presently claimed invention is directed to a matting agent that comprises a metal salt or metal complex of an organic compound and a polymerisation product of epoxy-group containing monomers having a specific epoxy value. Lauterbach fails to teach a matting agent that contains a polymerization product of epoxy-group containing monomers. The epoxy compound described in Lauterbach is part of the binder/cross-linker matrix. Moreover, Lauterbach fails to teach a matting agent comprising the polymerization product of epoxy-group containing monomers with the specific epoxy value recited in Applicants' independent claims 24 and 26. The epoxy value taught in Lauterbach is of the epoxy matrix resin, not of the matting agent. As the Examiner stated in the previous Office Action, Paper No. 5, page 4, Lauterbach fails to teach a separate epoxy polymer and epoxy cross-linking agent as in the presently claimed invention. Applicants submit that Lauterbach fails to teach each and every element as recited in Applicants' independent claims 24 and 26.

Chang et al. teaches a method for preparing a powder coating composition, wherein the powder coating composition comprises a curable resin, such as an epoxy resin, and a cross-linking agent. (Chang et al. at column 2, lines 8-11, 35-39 and 56-60). On page 3 of the present Office Action, the Examiner refers to the epoxy equivalents recited in Chang et al. at column 2, lines 61-64. However, this passage relates to the epoxy matrix resin and has nothing to do with matting agents. Furthermore, Chang et al. does not appear to teach a matting agent or any sort. Chang et al. never once mentions

matting agents. There is no specific purpose mentioned for the zinc stearate in Example 3, and in column 1, lines 44-47. Chang et al. suggests that “good gloss” is a desirable property in thermosetting coating compositions.

Applicants respectfully submit that the Examiner has failed to make a *prima facie* case of anticipation based on either Lauterbach or Chang et al. because neither reference teaches a matting agent comprising (i) a metal salt or a metal complex of an organic compound, (ii) and a polymerization product of epoxy-group containing monomers that is separate from the binder and cross-linking agent. Applicants request that the rejection be withdrawn.

### **III. Allowable Subject Matter**

The Examiner has indicated that claims 38, 40, 41, 51, 52, 55, 83-97 and 101-103 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims. Applicants have rewritten claims 38, 40, 51, 55, 83, 91, 101 and 102 accordingly and thereby request the allowance of these claims and those dependent upon them.

### CONCLUSION

Applicants believe that the present application is now in condition for allowance.


Favorable consideration of the application as amended is requested.

Respectfully submitted,

Proskauer Rose LLP

Date: July 2, 2004

By

  
Tiffany A. Levato  
Registration No. 50,160

Proskauer Rose LLP  
Patent Department  
1585 Broadway  
New York, NY 10036-8299  
Tel. (212) 969-3686 (direct)  
Fax (212) 969-2900